Remarks

Summary of Interview dated May 14, 2009

Applicants thank the Examiner for discussing this application with Applicants' representative, Curtis Behmann (Registration No. 52,523), during a telephonic interview on May 14, 2009.

The finality of the Office Action dated May 11, 2009 was discussed. In particular, the Examiner was requested to clarify whether the Office Action was a Final Action, as indicated on the first page, since there was no indication at the end of the Office Action that it was a final action.

The Examiner confirmed that the Office Action was meant to be final. The Examiner indicated that he would prepare an Interview Summary, which has now been received (dated May 21, 2009). The Examiner indicated in the telephone interview that if the Applicants wanted the Office Action dated May 11, 2009 to be withdrawn, it would be necessary to contact the Examiner separately and make such a request after receiving his Interview Summary.

Summary of Interview dated July 7, 2009

Applicants thank the Examiner for further discussing this application with Applicants' representative, Curtis Behmann (Registration No. 52,523), during a telephonic interview on July 7, 2009.

A proposed amendment to independent claim 1, and the other independent claims, was discussed, relating generally to the packet data services blacklist including a flag indicating whether an identification of a wireless network blacklisted in relation to the mobile device has been communicated to another device (a modified version of a feature of current claim 2). The cited references, in particular the Daly and Cooper references, were discussed in relation to the proposed claim amendments. The inclusion of further dependent claims to a "once blacklisted" table, or packet data services previous blacklist, was also discussed. (The proposed claim amendments are substantially similar to those reflected in the currently amended claims.)

Examiner Sefcheck indicated to the Applicants' representative that amendments to that effect would overcome the cited references and the current rejections. Agreement was reached on this point. The Examiner also indicated that he would need to update the search, particularly as the initial search was performed by the previous Examiner. Examiner Sefcheck further indicated his willingness to provide a courtesy telephone call to the Applicants' representative should there be further issues with respect to the currently amended claims.

Claims

Claims 1 to 16 are in the application. Claims 1, 2, 4, 7 and 10 are currently amended. Claims 11 to 16 are new.

Claim 1 is being currently amended to include the feature that the packet data services blacklist includes a flag indicating whether an identification of a wireless network blacklisted in relation to the mobile device has been communicated to another device, such as a server (as recited in new claim 11). Similar subject matter was previously presented in claim 2, and has now been removed therefrom. This feature is supported by the specification and drawings as originally filed, for example at paragraphs [0036] and [0046]-[0049] and in Figures 6B and 7. Independent method claims 4 and 10 are also currently amended to include a similar feature.

Claim 11 is a new mobile device claim including subject matter corresponding to method claim 9.

Claims 12 and 13 are new claims specifying that the other device can comprise a server. This feature is supported by the specification as originally filed, for example at paragraphs [0036] and [0046] and in Figures 5 and 6B.

Claims 14 to 16 are new claims directed to features of a historical blacklist, also referred to in the specification as a once-blacklisted" table. These features are supported by the specification as originally filed, for example at paragraph [0047] and in Figure 6B.

Drawings

The Examiner objects to Figure 8, stating that it should be designated as Prior Art. The enclosed replacement sheet designates Figure 8 as Prior Art. Withdrawal of the objection is respectfully requested.

Claim Objections

The Examiner objects to claims 1, 2, 4 and 10 previously on file because of the use of element numbers in (). Claims 1, 2, 4 and 10 are currently amended such that element numbers in parentheses have been removed, thereby overcoming the Examiner's objection.

Claim Rejections – 35 USC 103

The Examiner rejects claims 1 and 4-6 previously on file under 35 USC 103(a) as being unpatentable over Cooper (US 2003/0129979) in view of Khare et al (US 2002/0065067), hereinafter Khare.

Previous claim 2 was rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper in view of Khare as applied to claim 1, and further in view of Daly. Since currently amended claim 1 includes similar subject matter to previous claim 2, the Applicant will address the Examiner's rejection of previous claim 2, which will substantively address the rejection of previous claim 1 in view of the current amendments. The rejection of claims 4 to 6 will be addressed later.

The Examiner correctly acknowledges that Cooper does not explicitly disclose a flag indicating whether an identification of a blacklisted wireless network has been communicated to a server. The Examiner then turns to Daly to address that deficiency. It is respectfully submitted that Daly does not teach what Cooper lacks.

The Examiner refers to column 4, lines 34-41 of Daly. However, it is respectfully submitted that Daly teaches an entirely different arrangement. In Daly, a database within a service provider's network can be updated based on changes in telecommunication services. The

database can then be sent to mobile stations to update the database information within the mobile stations. (See column 4, lines 2-8). The passage at column 4, lines 34-41 of Daly referred to by the Examiner is reproduced below (emphasis added by Applicant):

> *"In an embodiment of the method more specifically directed to intelligent roaming, an intelligent roaming database is updated. Subsequently,* ***wireless telephones having over-the-air programmability are identified.*** *Then, an update status indicator for wireless telephone having this programmability is set. Then, in accordance with the method it is detected whether wireless telephone has its update status indicator set is activated.* ***If such a wireless telephone is detected to be activated then the intelligent roaming information in the updated database is transferred to the wireless telephone****. If the wireless telephone is detected to not be activated then the wireless telephone is designated to receive the updated intelligent roaming database when the wireless telephone is later activated."*

It is clear from this passage that the status indicator in Daly is used to indicate the wireless telephone's ability to be programmed over-the-air, by receiving information from a remote location. It does not refer to any capability of the wireless telephone to itself *transmit* updated information to a server or other remote location. Therefore, the indicator in Daly indicates the mobile device's ability to receive updated database information.

Daly does not teach or suggest the wireless telephone being able to transmit packet data services blacklist information to the server or database. Moreover, the indicator in Daly represents a communications capability of the wireless telephone. Daly does not teach or suggest *any* indication associated with a particular wireless network identified in a packet data services blacklist on a mobile device, let alone an indication of whether an identification of the wireless network has been communicated to a server.

In contrast, the claimed invention relates to a mobile device having a packet data services blacklist including a flag indicating whether an identification of a wireless network blacklisted in relation to the mobile device has been communicated to a server. This flag does not indicate a

capability of the mobile device to transmit or receive database information. Instead, the flag is used to indicate whether an identification of a wireless network, which has been blacklisted in relation to the mobile device, has been communicated to a server.

With respect to Khare, while Khare discusses indicating the availability of packet data services separate from voice services, there is no teaching or suggestion of transmission of packet data services blacklist information from a mobile device to another device, such as a server. Consequently, there cannot be any teaching or suggestion of a packet data services blacklist including a flag indicating whether an identification of a wireless network blacklisted in relation to the mobile device has been communicated to another device. Accordingly, Khare does not provide that which the combination of Cooper and Daly lacks.

It is respectfully submitted that there is no motivation to combine Cooper, Khare and Daly to yield the subject matter of currently amended claim 1. None of the three references discusses or suggests the transmission of packet data services blacklist information from the mobile device to another device. While Daly teaches an indication of a wireless telephone's ability to receive updated database information from another device, there is no indication in Cooper, Khare or Daly that the mobile device can indicate whether an identification of a wireless network blacklisted in relation to the mobile device has been communicated to another device.

Therefore, the Applicants submit that the combination of Cooper, Khare and Daly cannot teach or suggest the steps of currently amended claim 1.

The Examiner rejects previous claim 3 under 35 U.S.C. 103(a) as being unpatentable over Cooper in view of Khare as applied to claim 1, and further in view of Yasushi et al (US 20002/0046285), hereinafter Yasushi.

By virtue of its dependence on currently amended claim 1, claim 3 includes the feature that the packet data services blacklist includes a flag indicating whether an identification of a wireless network blacklisted in relation to the mobile device has been communicated to another device. The Applicant reiterates the arguments provided above in relation to currently amended claim 1 with respect to Cooper and Khare.

Yasushi teaches a data communication system which transmits data related to a mobile unit (such as a vehicle) to a server through a network line to update a database. Each data type can have an associated update condition specifying a condition of timing of transmission of updated data associated with the particular data type. Paragraph [0040] of Yasushi describes examples of vehicle-related data as vehicle data, driver data, music data, map data, traveling data, and address book data. Such data is updated periodically and Yasushi describes keeping track of the preceding update date and time. However, this periodically updated vehicle-related data is entirely different from an indication of a wireless network blacklisted in relation to a mobile device. Moreover, a vehicle data event transmission request flag as described in paragraph [0086] of Yasushi is used to request *preferential data treatment* compared to periodic requests. Therefore, the flag used in Yasushi has nothing to do with whether the data has been sent, but rather indicates a priority of the data type.

In contrast, the claimed invention relates to a mobile device having a packet data services blacklist including a flag indicating whether an identification of a wireless network blacklisted in relation to the mobile device has been communicated to a server. This flag does not indicate properties relating to *when* an update for a particular *data type* should be sent to a server, or the priority thereof, such as in Yasushi. Instead, the flag is used to indicate *whether* an identification of a wireless network, which has been blacklisted in relation to the mobile device, has been communicated to a server.

It is respectfully submitted that there is no motivation to combine Cooper, Khare and Yasushi to yield the subject matter of currently amended claim 1. None of the three references discusses or suggests the transmission of packet data services blacklist information from the mobile device to another device. While Khare discusses indicating the availability of packet data services separate from voice services, there is no teaching or suggestion of transmission of packet data services blacklist information from a mobile device to another device, such as a server. While Yasushi teaches specifying an update condition referring to the timing or priority of transmitting a particular updated data type to a server, there is no indication in Cooper, Khare or Yasushi that the mobile device can indicate whether an identification of a wireless network blacklisted in relation to the mobile device has been communicated to another device.

Therefore, the Applicants submit that the combination of Cooper, Khare and Yasushi cannot teach or suggest the steps of claim 3.

The Examiner rejects claims 1 and 4-6 previously on file under 35 USC 103(a) as being unpatentable over Cooper in view of Khare. The Applicants submit that the arguments provided above in support of the patentability of currently amended claim 1 (regarding the rejection of previous claim 2) apply with respect to this rejection, and such arguments are reiterated and re-applied to this rejection.

Claim 4 is also currently amended along similar lines as claim 1 to include the following additional steps in the recited method: determining whether an identification of a wireless network newly blacklisted in relation to the mobile device has been communicated to another device; and notifying the other device of the newly blacklisted wireless network if it is determined that the identification has not been communicated to the other device.

The Examiner correctly identifies that Cooper does not explicitly disclose determining whether the wireless network specifically provides packet data services to the mobile device distinct from voice services. The Examiner then turns to Khare to address that deficiency. It is respectfully submitted that neither Cooper nor Khare, nor a combination thereof, teaches the additional features in currently amended claim 4.

Cooper does not teach providing packet data services distinct from voice services. Moreover, there is no teaching or suggestion in Cooper regarding the transmission of packet data services blacklist information. While Khare discusses indicating the availability of packet data services separate from voice services, there is no teaching or suggestion of transmitting any information regarding packet data services from the mobile device to another device. Consequently, there cannot be any teaching or suggestion of determining whether an identification of a wireless network newly blacklisted in relation to the mobile device has been communicated to another device. Furthermore, there is no teaching or suggestion of notifying the other device of the newly blacklisted wireless network if it is determined that the identification has not been communicated to the other device. Accordingly, Khare does not

provide that which Cooper lacks, and there is no motivation to combine the references to yield the features of currently amended claim 4.

Therefore, the Applicants submit that the combination of Cooper and Khare cannot teach or suggest the steps of currently amended claim 4.

Claims 5 and 6 depend from currently amended claim 4 and include all of its features and limitations. It is respectfully submitted that, at least because of their dependence from currently amended claim 4, dependent claims 5 and 6 are also patentable.

The Examiner rejects previous claims 7 and 9 under 35 U.S.C. 103(a) as being unpatentable over Cooper in view of Khare as applied to claim 4, and further in view of Yasushi and Daly. The Applicants submit that the arguments provided above regarding Cooper and Khare in support of the patentability of currently amended claim 4 apply with respect to this rejection, and such arguments are reiterated and re-applied to this rejection.

The Applicants also submit that the arguments provided above regarding Yasushi in support of the patentability of currently amended claim 1 also apply in relation to the steps of claims 7 and 9, which depend from currently amended claim 4, and such arguments are reiterated and re-applied to this rejection. The Applicants further submit that the arguments provided above regarding Daly in support of the patentability of currently amended claim 1 also apply in relation to the steps of claims 7 and 9, which depend from currently amended claim 4, and such arguments are reiterated and re-applied to this rejection.

With respect to claim 7, the Examiner correctly states that Cooper does not explicitly disclose notifying a server of a newly blacklisted wireless network. The Examiner then turns to Yasushi to address that deficiency. The Examiner states that Yasushi discloses a method to maintain a composite list which is based on data sent (notified) to the server from the mobile device to update the database.

Also with respect to claim 7, the Examiner correctly states that Cooper does not explicitly disclose receiving a composite packet data services blacklist from a server, and turns to Daly

to address that deficiency. The Examiner states that Daly discloses a method which allows a database to be sent from a server to a mobile device to update the mobile's database.

With respect to claim 9, the Examiner correctly states that Cooper does not disclose sending a notification to a service if a mobile device find a wireless network which was not previously providing packet data services to the mobile device and is now providing packet data services to the mobile device. The Examiner then turns to Yasushi to address that deficiency. The Examiner states that Yasushi discloses updating the database in a server with the update condition received from various mobile units.

As outlined earlier, currently amended claim 4 (from which claim 7 depends) includes the features of determining whether an identification of a wireless network newly blacklisted in relation to the mobile device has been communicated to another device; and notifying the other device of the newly blacklisted wireless network if it is determined that the identification has not been communicated to the other device. In Yasushi, a timer is set to determine when to send information to a server, or a flag is used to indicate properties relating to *when* an update for a particular *data type* should be sent to a server, or the priority thereof.

Daly does not teach or suggest the wireless telephone being able to transmit packet data services blacklist information to the server or database. Moreover, Daly uses an indicator to represent a communications capability of the wireless telephone. Daly does not teach or suggest *any* indication associated with a particular wireless network identified in a packet data services blacklist on a mobile device, let alone an indication of whether an identification of the wireless network has been communicated to a server.

In contrast, the claimed invention relates to a method including determining whether an identification of a wireless network blacklisted in relation to the mobile device has been communicated to another device, such as a server. The method also includes notifying the other device of the newly blacklisted wireless network if it is determined that the identification has not been communicated to the other device.

Therefore, the Applicants submit that the combination of Cooper and Khare, further in view of Yasushi and Daly, cannot teach or suggest the steps of claims 7 and 9, which depend from currently amended claim 4.

The Examiner rejects previous claim 8 under 35 U.S.C. 103(a) as being unpatentable over Cooper in view of Khare and further in view of Marran (US 6,549,770).

The Examiner correctly states that Cooper does not explicitly disclose clearing the packet data service blacklist in response to a provisioning reset condition. The Examiner then turns to Marran to address that deficiency. Marran discloses updating or correcting data stored in a mobile station under various conditions.

As outlined earlier, currently amended claim 4 (from which claim 8 depends) includes the features of determining whether an identification of a wireless network newly blacklisted in relation to the mobile device has been communicated to another device; and notifying the other device of the newly blacklisted wireless network if it is determined that the identification has not been communicated to the other device.

Marran teaches various methods for over-the-air provisioning of mobile digital devices. There some discussion in Marran of preferred roaming lists and updating preferred roaming lists. There is no mention of blacklists in Marran. Consequently, there cannot be any teaching or suggestion of communicating blacklists, and managing notifications relating to a newly blacklisted wireless network.

In contrast, the claimed invention relates to a method including determining whether an identification of a wireless network blacklisted in relation to the mobile device has been communicated to another device, such as a server. The method also includes notifying the other device of the newly blacklisted wireless network if it is determined that the identification has not been communicated to the other device.

Therefore, the Applicants submit that the combination of Cooper and Khare, further in view of Marran, cannot teach or suggest the steps of claim 8, which depends from currently amended claim 4.

The Examiner rejects previous claim 10 under 35 U.S.C. 103(a) as being unpatentable over Tiedemann et al (US 5,642,398), hereinafter Tiedemann, in view of Daly.

The Examiner states that Tiedemann discloses a method of packet data service notification in a wireless network, wherein the server receives a registration of a newly powered-up mobile device. The Examiner correctly states that Tiedemann does not explicitly disclose retrieving server-stored information regarding packet data services distinct from voice services and sending the server-stored packet data services information to a newly powered-up mobile device for reception by and storage on the mobile device. The Examiner then turns to Daly to address that deficiency. The Examiner states that Daly teaches sending network information from server to mobile station regarding voice and data communication channels to update the database within the mobile station which is used to control the roaming operation.

Currently amended claim 10 includes the following steps: updating the server-stored packet data services blacklist in response to receiving an identification of a wireless network blacklisted in relation to another mobile device; and sending the updated server-stored packet data services blacklist from the server to the newly powered-up mobile device for reception by and storage on the mobile device.

Tiedemann teaches registration of a mobile device with a wireless network. As mentioned in column 1, lines 19-22 and 50-52 of Tiedemann: *"In a cellular communication system registration is the process a mobile station uses to notify a cellular communication system whether it is on the air and which base station it is receiving…A mobile station uses a process called registration to inform the cellular system where the mobile station is located."*

Clearly, the simple communication involved in registration in Tiedemann is completely different from the method in currently amended claim 10. The data communicated during registration relates only to the specific mobile device and the base station with which it is communicating.

This data is clearly unrelated to a packet data services blacklist of any sort. Moreover, even if one were to argue the similarity of the communication of data, regardless of the type of data, such an argument fails since the registration information of one mobile device is not used, and cannot be used, to update any type of data that is then sent to another mobile device. Consequently, even in the communication from the mobile device to the server, Tiedemann fails to teach or suggest anything remotely similar to currently amended claim 10.

Daly does not teach or suggest a wireless telephone being able to transmit packet data services blacklist information to the server or database. Daly describes over-the-air programming of telecommunication services to a station. If a flag indicates the station is inactive, the service information is updated upon registration of the mobile station. Daly does not teach or suggest updating its teleservice information for one mobile station using information received from another mobile station. The communication in Daly is primarily from a server to a mobile station.

There is no suggestion or motivation to combine Daly with Tiedemann, given that neither indicates the desirability of updating packet data services information in two-way communication between a mobile station and a server. Moreover, there is no suggestion whatsoever of using data from one mobile station to update service information for another mobile station.

As such, it is respectfully submitted that neither Tiedemann nor Daly, nor a combination thereof, teaches or suggests: updating the server-stored packet data services blacklist in response to receiving an identification of a wireless network blacklisted in relation to another mobile device; and sending the updated server-stored packet data services blacklist from the server to the newly powered-up mobile device for reception by and storage on the mobile device.

Therefore, the Applicants submit that the combination of Tiedemann and Daly cannot teach or suggest the method of currently amended claim 10.

With respect to new claims 11, 12 and 13, by virtue of their dependence on currently amended independent claims 1 and 4, the Applicants submit that these new claims are patentable in view of the cited references. The Examiner is directed to the arguments provided above with respect to the distinguishing features of the independent claims.

With respect to new claims 14-16, the mobile device defined in new claim 14 comprises a historical blacklist provided in the memory, distinct from the packet data services blacklist and the voice services blacklist. The historical blacklist identifies wireless networks that are no longer in the packet data services blacklist and were once in the packet data services blacklist within a particular time period. Support for this amendment is found at least in paragraphs [0046]-[0047] and Figure 6B of the application as originally filed. Similar subject matter is provided in method claims 15 and 16.

The Applicants respectfully submit that none of the cited references, either alone or in combination, teaches or suggests a historical blacklist provided in memory in a mobile device. The cited references describe the use of age timers or other means to determine when a wireless network is to be removed from a blacklist. However, once a wireless network is removed from the blacklist, there is no record kept of that wireless network.

Therefore, it is respectfully submitted that claims 1 to 16 comply with 35 U.S.C. 103(a), and withdrawal of the rejections is requested.

The Application is now believed to be in condition for allowance, and early action in that respect is courteously solicited.

The Commissioner is hereby authorized to charge any additional fees, and credit any over payments to Deposit Account No. 501593, in the name of Borden Ladner Gervais LLP.

Respectfully submitted,

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